



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,998	12/21/2001	L. Lloyd Williams	SWA01 P-107	5702

7590 08/03/2005

VAN DYKE, GARDNER, LINN & BURKHART, LLP
Suite 207
2851 Charlevoix Drive, S.E.
Grand Rapids, MI 49546

EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/036,998		WILLIAMS, L. LLOYD	
	Examiner		Art Unit	
	James H. Zurita		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10,12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's preliminary amendment of 23 July 2003 cancelled claims 19-32.

Applicant's election without traverse of Invention *I.d* (claims 1, 2, 10, 12, 14, 15) in the reply filed 6 May 2005 is acknowledged. Applicant also cancelled claim 18.

Claims 1-17 are pending, of which claims 3-9, 11, 13, 16-17 are drawn to a non-elected invention.

Specification

The disclosure is objected to because of the following informalities, most of which appear to be typing errors:

In this and future Office Actions, cited paragraph numbers correspond to numbers found in PG-PUB 2003/0120553, published 26 June 2003. Please subtract 17 from each number to derive the paragraph number of the originally filed disclosures.

Paragraph 61, top of page 5, reads "...This portion may permit the input of two or more telephone numbers to permit any one of service persons to be phoned." The Examiner believes this was intended to read "...This portion may permit the input of two or more telephone numbers to permit any one of **several** persons to be phoned."

In paragraph 73, "STP pair **222**" should be changed to "STP pair **220**."

In paragraphs 72, 74, 78, 79, "STP **220**" should be changed to "STP pair **220**."

Paragraph 76 refers to "...via the STP pair **220 284** [sic] in response to..."

Paragraph 78 refers to "...STP **220 38** [sic] forwards the ANM message **332**..."

The description refers to SS7 A-link 222, A-link 222, SS7 A-link 224 and A-link 224. There does not appear to be a patentable distinction among the various terms. For purposes of this examination, the terms will be treated as synonyms.

Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the features cancelled from the claims; no new matter should be entered.

- *call duration report*
- *database*
- *Call request message*
- *Internet protocol address*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4):

- reference character "**210**" has been used to designate both subscriber line [paragraph 71] and EISUP [paragraph 73]. Later references to subscriber lines refer to references 228 and 230. Reference 210 does not appear in Fig. 1.
- reference characters "**68**" and "**74**" have both been used to designate *electronic certificate*.

Paragraph 65, which purports to describe Fig. 6, does not have the steps found in Fig. 6. For example, there is no description of reference 177.

Fig. 5B contains reference 100, which is not mentioned in the description.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

Art Unit: 3625

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Objections

The following claims are objected to because of informalities:

Claim 1 refers to Pre-paid/prepaid call credit. Other claims refer to call credit.

Claims 1, 10, 14 and 15 refer to an "...application server..." The label will be interpreted to mean a node on a network that provides some function.

Claims 2 and 10 refer to an icon, i.e., a small picture that represents an object or program; Icons are a principal feature of graphic user interfaces.¹ Paragraph 58 refers to a call icon 76 located on a button of the [...electronic certificate...]

Claim 10 refers to receiving a number of items of information, including an Internet Protocol (IP) address. The sole mention of IP address appears in paragraph 20 of the disclosures. Applicant does not provide any description of how the information is used, if at all. For purposes of this examination, claim 10 will be interpreted as being

¹ Definition of *icon*, RANDOM HOUSE WEBSTERS Computer and Internet Dictionary.

Art Unit: 3625

directed to receiving an additional piece of information that is not used, that is, as nonfunctional descriptive material.

Claims 10, 12, 14 and 15 refer to call control node, while claim 14 also refers to a CCN. The claims will be interpreted to refer to a node on a network that performs call control functions, that is, setting up, monitoring and tearing down of telephone calls.²

Claim 10 refers to Internet protocol address, which is mentioned in paragraph 20, but not otherwise used. There is no explanation as to how the item is used.

Claim 15 refers to "...calculating a charge for the telephone call using the call duration..." but does not specify whether "...call duration..." refers to maximum call duration (claim 12), actual call duration (claim 14) or call duration report (claim 15). For purposes of this examination, the term will be interpreted to mean the ordinary process of obtaining the duration of a phone call from a telephone network.

Claims 1, 2 and 10 refer to "...electronic certificate..." Applicant's use of the term "...certificate..." would render the claim indefinite for the following reasons:

The disclosures include at least the following versions of "...certificate..." which appear to be synonyms:

- "call me" certificate
- call certificate
- call credit certificate
- certificate redemption server
- certificate
- electronic call certificate
- electronic call credit certificate
- electronic personalized gift certificate
- emailed electronic certificate
- gift certificate
- pre-paid electronic call certificate

² Definition of call control, NEWTON'S TELECOM DICTIONARY.

Further, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

Applicant's use of "...certificate..." while not repugnant to ordinary meaning, is used by applicant in a generic manner that is not consistent with the meaning of the term. Certificate is a cryptography term; it is also known as a digital certificate, a password-protected, encrypted data file that includes the name and other data which it services to identify the transmitting entity; the certificate also includes a public key with servers to verify the digital signature of the sender.³ For purposes of this examination, the term "...certificate..." will be given its broadest reasonable interpretation to refer to a document that evidences ownership or debt.⁴

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

³ Definition of *certificate*, NEWTON'S TELECOM DICTIONARY.

⁴ Definition of *certificate*, MERRIAM WEBSTERS Collegiate Dictionary.

Claims 1, 2, 10, 12, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karas et al. (US PG-PUB 20020138363) in view of Elliott et al (US 6,614,781).

As per claim 1, Karas discloses methods for providing electronically mailable prepaid credits, including the following steps:

- (a) receiving from a customer at an application server via a data network, a purchase order of a specified purchase value for the pre-paid credits. See, for example, at least Fig. 6, step 604.
- (b) collecting and verifying payment information to collect payment for the purchase value. See, for example Fig. 6, step 616 and related text.
- (c) issuing at the application server an electronic certificate for the purchase value of the credits, the certificate including purchase value (paragraph 19), an unique identifier (paragraph 54) for identifying the purchase order and an email address of a recipient of the credits designated by the customer in the purchase order. See, for example, at least Fig. 6 and step 624, concerning sending a greeting card to a recipient via e-mail. See also paragraph 3 concerning sending greeting cards via e-mail.
- (d) storing information in a database. See at least paragraph 34, and also references to database 324.
- (e) sending a copy of the electronic certificate to the recipient via email using the email address. See, for example, at least Fig. 6, reference 624.

Karas **does not** specifically disclose that prepaid credits are prepaid **call** credits. Karas suggests application of his system to telephone cards. Elliott discloses prepaid call credits. See, for example, at least Col. 226, line 31-Col. 227, line 67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Karas and Elliott to disclose electronically mailable prepaid call credits. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Karas and Elliott for the obvious reason that this would enable seamless integration of voice services over various networks.

As per claim 2, Karas discloses that the electronic certificate includes an icon used for linking to a web interface and initiate activity using the account on the server. See, for example, at least paragraph 51. Karas discloses that prepaid cards may be created and sent for prepaid phone calls, as in paragraphs 19, 24, 31. Karas discloses charging against a credit associated with a certificate, as in paragraphs 37 and 51.

As per claim 10, Karas discloses processing a request for a purchase and deducting credits from a customer's account information stored in a database.

(a) *receiving* at an application server a request as a result of an action by the recipient who activates the icon. See, for example, at least Fig. 6 and step 624, concerning sending a greeting card to a recipient via e-mail. See also paragraph 3 concerning sending greeting cards via e-mail.

(b) *verifying the* electronic certificate using the unique identifier to locate the information stored in the database. See at least paragraph 34, database 324.

As per claim 10, Karas ***does not*** specifically disclose processing a request for a call. These detailed features of requesting and placing a phone call over various networks is disclosed by Elliott. For example, Elliott discloses:

(a) *using* a calling telephone number, an Internet Protocol (IP) address (see at least Col. 112, line 64-Col. 113, line 30) of the recipient and a telephone number of a party to be called by the recipient. See, for example, at least references to CDR (call detail record), which includes both telephone numbers. See references to CDR database, Col. 47, lines 7-39.

(c) *sending* a call request message to a call control node (as in call control server, Col. 140, lines 14-58) in a switched telephone network (col. 1, lines 23-44, for example) to instruct the call control node to initiate actions in the switched telephone network to establish a telephone connection (see, for example, initiating a call in an SS7 telecommunications network, at least Col. 2, lines 29-Col. 3, line 8) between the calling telephone number and the called telephone number (see references to called and calling parties, as in Col. 2, lines 51-Col. 3, line 8).

As per claim 12, Karas ***does not*** provide details for handling telephone numbers and call duration. Elliott discloses that a call request message sent to the call control node includes the calling and called telephone numbers (see references to CDR, call detail record) and a maximum call duration determined using a remaining value of the credits and the unique identifier. See, for example, at least references to usage cap limits, as in Col. 224, line 39-Col. 226, line 31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Karas and

Art Unit: 3625

Elliott to disclose that a call request message sent to the call control node includes the calling and called telephone numbers and a maximum call duration determined using a remaining value of the credits and the unique identifier. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Karas and Elliott to disclose that a call request message sent to the call control node includes the calling and called telephone numbers and a maximum call duration determined using a remaining value of the credits and the unique identifier for the obvious reason that different industries may have different ways for charging for their services. In a telephone system, for example, it is important to charge by call duration.

As per claim 14, Karas ***does not*** specifically discloses reporting from the call control node to the application server an actual call duration after the telephone communication is completed or is terminated by the CCN after the maximum call duration has expired. This feature is disclosed by Elliott, for example, who refers to call duration, as in Col. 1, lines 22-56. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Karas and Elliott to disclose reporting from the call control node to the application server an actual call duration after the telephone communication is completed or is terminated by the CCN after the maximum call duration has expired.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Karas and Elliott to disclose reporting from the call control node to the application server an actual call duration after the telephone communication is completed or is terminated by the CCN after the maximum call duration has expired

for the obvious reason that telephone service is often measured and billed by actual duration of a call.

As per claim 15, Karas discloses

(b) *retrieving* at the application server from the database the information associated with the unique identifier, as in paragraph 54, which shows an identifier matched with a database record of paragraph 34.

(c) *calculating* a charge for the telephone call using the call duration. See at least paragraph 37 and other references to billing function.

(d) *deducting* the charge from the remaining value of the credits to yield an updated remaining value. See at least Karas, paragraph 37, concerning deducting charges from a transfer. See also Fig. 8, reference 884.

(e) storing the updated remaining value of the credits in the database with the information associated with the unique identifier. See at least Karas, paragraph 37, concerning deducting charges from a transfer.

As per claim 15, Karas ***does not*** specifically disclose an application of his invention to providing telephone services. Elliott discloses

(a) *receiving* at the application server from the call control node via the data network a call duration report associated with the unique identifier. See, for example, at least Col. 20, lines 14-36. See also references to reporting and billing, as in Col. 234, line 37- Col. 236, line 3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
25 July 2005

James Zurita
Patent Examiner
Art 3625